

**REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application in view of the following remarks. Upon entry of this amendment, claims 48-50, 54, 55, 57-85, 87, 88 and 90-126 are pending and at issue. It is believed that no fees in addition to the requisite fee for a one-month extension of time are due for entry of this response. However, if additional fees are due, the Commissioner is authorized to charge such fees to Deposit Account No. 13-2855.

**Claim Rejections Under 35 U.S.C. § 112**

Claims 53 and 86 stand rejected under 35 U.S.C. § 112, first and second paragraphs. In order to advance the prosecution of the present application, claims 53 and 86 are canceled hereby. Consequently, applicants respectfully requests withdrawal of the rejection of the canceled claims.

**Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 48-50, 54, 55, 59-63, 78-84, 92-97 and 111-126 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* (U.S. Patent No. 5,816,918) in view of Deaton *et al.* (U.S. Patent No. 5,642,485), claims 57, 58, 90 and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* and Deaton *et al.* as applied to claims 48 and 84, and further in view of Harlick (U.S. Patent No. 5,941,773), claims 64 and 98 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* and Deaton *et al.* as applied to claims 48 and 84, and further in view of Harrison (U.S. Patent No. 5,934,671), claims 65, 66 and 99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* and Deaton *et al.* as applied to claims 48 and 84, and further in view of Baerlocher *et al.* (U.S. Patent No. 5,788,573), claims 67-77 and 100-110 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* and Deaton *et al.* as applied to claim 48, and further in view of Mullins (U.S. Patent No. 5,158,293), and claims 123-126 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly *et al.* and Deaton *et al.* as applied to claim 116, and further in view of Boushy (U.S. Patent No. 5,761,647). Reconsideration is respectfully requested.

Regarding the rejections of claims 48-50, 54, 55, 59-63, 78-84, 92-97 and 111-115 as unpatentable over Kelly *et al.* in view of Deaton *et al.* either alone or in combination with

other references, applicants reassert that the Examiner has not established a *prima facie* case of obviousness because there is no suggestion or motivation to combine Kelly *et al.* and Deaton *et al.* in the manner proposed by the Examiner for the reasons discussed in the preceding response and further detailed herein. The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability, and if examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). In order to establish a *prima facie* case of obviousness, there must be *actual evidence* of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be *clear and particular*. See, e.g., *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...

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The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not** ‘evidence.’ (emphasis added, citations omitted).

The mere fact that references *can* be modified is *not* sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990)” (emphasis original). The suggestion to combine references must be from the *prior art*, not Applicants’ disclosure. See Section 2143 of the M.P.E.P., which states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Kelly *et al.* teaches dispensing tickets from a universal ticket dispenser 20 and a specific ticket dispenser 22 based on a player achieving a predetermined goal or task during a

game. *See Kelly et al.*, column 8, lines 25-32. The tickets dispensed by the dispensers 20 and 22 are then redeemable for prizes at prize booths or prize vending machines at the arcade. *Kelly et al.*, column 8, lines 40-48. The amount of the tickets dispensed to the player is based upon a game score or other result of a game process, or achievement of special or progressive goals by the player. *See Kelly et al.*, column 9, lines 21-25. Consequently, the only tickets dispensed by Kelly's game unit are game awards.

The Examiner's comments in the rejection appear to suggest ambiguity in *Kelly et al.* as to whether the promotional coupons are gaming awards. In the comments accompanying the rejection, the Examiner implies that he's making a concession by granting that a ticket in the form of a promotional coupon *may* be considered a gaming award. Later, in the Examiner's Response to Arguments, the Examiner more emphatically states that "[w]hile [he] does not believe that Kelly awards the comps as a gaming award, there is room for reasonable doubt." Applicants respectfully submit that there is no ambiguity or reasonable doubt that *Kelly et al.* discloses dispensing promotional coupons that are gaming awards. In one embodiment, the tickets dispensed from the gaming units based on the outcome of games are redeemed for prizes, one of which may be a promotional coupon. *See Kelly et al.*, column 8, lines 54-63. In another embodiment, promotional coupons are dispensed as a specific prize ticket from the specific prize ticket dispenser 22 based on the outcome of the game. *See Kelly et al.*, column 8, lines 63-67. Therefore, the promotional coupons, along with all the other prizes for the game are either dispensed from the game units as game awards or received in exchange for the tickets dispensed as game awards, in which case the prizes are not even dispensed from the gaming unit. In fact, by teaching the awarding of prizes such as merchandise, souvenirs, food items and other physical goods and services based on the outcome of the game at the gaming unit, *Kelly et al.* actually teaches away from dispensing such goods and services, or coupons for such prizes, as something other than gaming awards as recited in the claims. A player must have a successful outcome to the game in order to receive tickets or prizes. For these reasons, *Kelly et al.* provides no clear and particular actual evidence of a suggestion or motivation for dispensing tickets that are not gaming awards from a gaming unit, and in fact teaches away from doing so by disclosing the awarding of many different types of prizes, including goods and services, as game awards.

Deaton *et al.* does not provide a suggestion or motivation for dispensing tickets at a gaming unit that are not game awards because Deaton *et al.* relates to point-of-sale terminal units or registers, and not to gaming units. The Examiner accurately points out that Deaton *et al.* does not disclose issuing coupons that are not gaming awards, or dispensing coupons in response to a triggering event that is not a predetermined winning outcome of a waging game or the cumulative result of a plurality of winning outcomes of a wagering game. These are not surprising conclusions in view of the fact that Deaton *et al.* is a patent relating to *cash registers*. Cash registers and other point-of-sale terminals do not issue gaming awards and do not dispense tickets or coupons in response to winning outcomes of wagering games because they are altogether unrelated to wagering games. Deaton *et al.* contains no disclosure or suggestion of implementing its system in gaming units or in a gaming environment and, therefore, provides no clear and particular actual evidence of a suggestion or motivation for dispensing coupons from a gaming unit in addition to the game awards dispensed by the gaming unit as recited in the claims.

In the comments accompanying the rejection, the Examiner states in conclusory fashion that it would be obvious to modify Kelly *et al.* in view of Deaton *et al.* “in order to encourage the player to return to the current gaming location in the future.” The statement is not supported by the Examiner with any actual evidence, let alone clear and particular evidence, of a suggestion or motivation to combine the references in the manner proposed by the Examiner. As discussed above, neither reference provides a suggestion or motivation for being combined with the other reference. Moreover, the Examiner does not cite to any other reference to support the proposed combination of these two particular references. Applicants respectfully submit that the Examiner has not satisfied the burden of presenting a *prima facie* case of unpatentability supported by actual evidence of a suggestion or motivation to combine or modify the references, and respectfully request withdrawal of the rejections of claims 48-50, 54, 55, 59-63, 78-84, 92-97 and 111-115.

The Examiner’s Response to Arguments previously submitted by the applicants does nothing more than state in conclusory terms that casinos and grocery stores are both motivated to build and maintain customer loyalty and, therefore, have sufficient motivation to combine Kelly *et al.* and Deaton *et al.* Of course, virtually every commercial endeavor is motivated to build and maintain customer loyalty, including the automobile industry and any

other producer and seller of goods, the software industry, service industries such as accounting and the legal profession, and even the United States Patent and Trademark Office. Under the Examiner's analysis, references from any two industries may be combined if the businesses within the industries want to encourage customers to return for repeat business. Applicants respectfully assert, and are supported by the authority cited above, that the Examiner **must** provide actual evidence of the suggestion or motivation to combine the particular references being applied in order to establish a *prima facie* case of obviousness. Applicants respectfully submit that the conclusory and unsupported assertions of the Examiner in support of the proposed combination do not satisfy this burden, and withdrawal of the rejections is respectfully requested.

Given the absence of supporting evidence for the Examiner's assertions regarding the motivation to combine the references, applicants respectfully submit that the Examiner is impermissibly using the applicants own specification to provide the suggestion for the proposed combination. The Federal Circuit has noted the impropriety of such an analysis:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

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Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --the essence of hindsight.

*In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 2000) (citations omitted) (emphasis added). Without the applicants own disclosure, no actual evidence exists of a motivation for modifying Kelly *et al.* to dispense tickets that are not gaming awards. As noted above, Kelly

*et al.* even teaches away from dispensing such tickets by providing tickets or coupons as game awards that are redeemable for other goods and services. Moreover, even with the applicants' disclosure, it is tenuous to suggest that a person skilled in the gaming art would look to a point-of-sale terminal system for dispensing an additional non-gaming award from a gaming unit. The only motivation for the claimed invention is provided by the Applicants' own specification, the use of which constitutes impermissible hindsight analysis. Because there is no clear and particular suggestion or incentive to combine the references in the manner proposed by the Examiner based on actual evidence, it follows that the Kelly *et al.* and Deaton *et al.* references do not render claims 48-50, 54, 55, 59-63, 78-84, 92-97 and 111-115 obvious.

Regarding the rejections of claims 116-126, applicants respectfully reassert the arguments presented in the previous response and the arguments detailed above, and respectfully submits that the Examiner has also failed to establish a *prima facie* case of unpatentability of claims 116-126. In claims 116-126, comp points are accumulated for the players *independent* of the outcome of the randomly determined wagering game and the skill of the player. As discussed above, Kelly *et al.* only discloses awarding credits/award tickets based on winning outcomes of the wagering game and, therefore, are directly *dependent* on the outcome of the game. As further discussed above, Deaton *et al.* is unrelated to gaming and, for obvious reasons, does not disclose accumulating comp points that are dependent on the outcome of a wagering game. Deaton *et al.* does not teach or suggest anything about wagering games and, consequently provides no motivation for being combined with wagering games. As still further discussed above, the Examiner provides no clear and particular actual evidence of a motivation to combine the references as proposed and, if anything, impermissibly uses hindsight analysis based on the applicants own specification to arrive at the proposed combination. Based on the absence of a teaching of accumulating comp points independent of the outcome of a wagering game, and the absence of actual evidence of a motivation or suggestion to combine the references as proposed, applicants respectfully submit that the Examiner has not established a *prima facie* case of unpatentability, and withdrawal of the rejections of claims 116-126 is respectfully requested.

Entry and consideration of the foregoing amendment as improving the form of the application are solicited. The amendment has the effect of narrowing the issues for

consideration by Examiner Coburn, or on appeal, and were not earlier presented because, prior to the final Office action and Examiner Coburn's comments therewith, these amendments were not felt necessary to obtain allowance.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Dated: February 23, 2005

Respectfully submitted,

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